

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the present amendments and the following discussion, is respectfully requested.

Claims 28-32, 34-53, and 55 are pending. By the present amendment, Claims 28-32, 34-50, 52, and 53 are amended, Claim 55 is newly added, and Claims 33 and 54 are canceled. Support for the amendment to Claim 28 may be found in the specification at paragraphs [0083] to [0086], for example. Support for the amendments to Claims 43 and 47 may be found at least in Claim 44 and in the specification, as published, at paragraphs [0046], [0075], and [0084]. Support for the amendment to Claim 48 may be found in Claim 44, for example. Support for the amendments to Claims 29-32, 34-42, 44-46, 49, 50, 52, and 53 is self-evident. Support for newly added Claim 55 may be found in Claim 39, and in the specification, as published, at paragraph [0062], for example. Thus, no new matter is added.

In the outstanding Office Action, Claims 28, 30-35, 37-42, 44, 45, 50, and 54 were objected to because of informalities. Claims 29, 38, and 40 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claim 43 was rejected under 35 U.S.C. § 101 as failing to recite statutory subject matter. Claims 28-41, 43-49, and 52 were rejected under 35 U.S.C. § 102(b) as anticipated by a public use or sale evidenced by “Andersen Windows · Doors, Introduction,” dated 7/7/05, hereinafter, “Andersen.” Also relied on to reject Claim 40 was “IGCC - Initial Certification Process,” dated 1/8/2010, hereinafter, “IGCC.” Claims 47, 50, 51, 53, and 54 were rejected under 35 U.S.C. § 102(b) as anticipated by an archived page of Andersen Corporation’s website entitled, “Double Hung Windows Average Unit Performance,” dated 1996. Claim 42 was rejected under 35 U.S.C. § 103(a) as unpatentable over Andersen in view of Demars et al. (WO 03/040507 and US 7,332,202, hereinafter “Demars”).

Regarding the objection to Claims 28, 30-35, 37-42, 44, 45, 50, and 54, all the informalities cited in the outstanding Office Action are addressed by the present amendment. Specifically, Claims 28, 30-35, 37-42, 44 and 45 are amended to recite “the at least one marking element,” Claim 34 is amended to recite “an identifier,” Claims 33 and 54 are canceled, Claim 39 is amended to recite “on the at least one interlayer,” and Claim 50 is amended to depend from Claim 47. Thus, it is respectfully requested that the objections to Claims 28, 30-35, 37-42, 44, 45, 50, and 54 be withdrawn.

Regarding the rejection of Claims 29, 38, and 40 as indefinite, these claims are amended to delete the term “and/or.” Accordingly, Applicants respectfully submit that the rejection of these claims as indefinite is negated and request the rejection be withdrawn.

In response to the rejection of Claim 43 under 35 U.S.C. § 101 as directed to non-statutory subject matter, that rejection is respectfully traversed by the present response.

Recently, the Federal Circuit, in In re Bilski, 545 F.3d 943 (Fed. Cir. 2008), recognized the “machine-or-transformation test” as the proper test for evaluating subject matter eligibility. The Bilski court stated:

The machine-or-transformation test is a two-branch inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is **tied to a particular machine**, or by showing that his claim **transforms an article** First, . . . the use of a specific machine or transformation of an article must impose meaningful limits on the claim’s scope to impart patent-eligibility Second, the involvement of the machine or transformation in the claim process must not merely be insignificant extra-solution activity.¹

Amended independent Claim 43 meets the requirements the Bilski court set forth as it is tied to a particular machine and the involvement of the machine is meaningful and not merely insignificant extra-solution activity.

¹ In re Bilski at 961-62 (emphasis added).

Specifically, amended independent Claim 43 recites, in part:

after the recognizing, transmitting a content of the at least one marking element via **a first technical communication device to an identification device including a computer database**,
identifying via the **identification device** one or more hexadecimal numbers from a string of characters of the at least one marking element,
correlating via **the computer database** the one more numbers with an item of information in the computer database, and passing-on at least some of the item of information publicly via **a second technical communication device**.

In this case, the Claim 43 is sufficiently tied to more than one particular machine.

Specifically, transmitting via a first technical communication device to an identification device including a computer database, identifying via the identification device, correlating via the computer database, and passing-on via a second technical communication device. Furthermore, the identification device and the first and second technical communication devices are central to the execution of the above-noted steps, and thus, their recitation is meaningful and not merely extra-solution activity.

Accordingly, Applicants respectfully submit the method recited in amended independent Claim 43 is directed to patentable subject matter according to the above-noted discussion regarding In re Bilski, and Applicants respectfully request the rejection of Claim 43 under 35 U.S.C. § 101 be withdrawn.

Regarding the rejection of Claims 28-41, 43-49, and 52 as anticipated by Andersen, those rejections are respectfully traversed by the present response.

Amended independent Claim 28 recites:

A glazing unit comprising:
at least one marking element visible from outside the glazing unit, the at least one marking element including a string of characters which contain **one or more substrings of one or more successive characters** where at least one of the **one or more substrings is a hexadecimal number**,
wherein the marking element can be visually identified by whomsoever and **an identity of the at least one marking element can be communicated remotely to an identification device**, the identification device incorporating, for a given marking element, characteristics relating to the glazing unit which are configured to be at least partly accessible to the public in exchange for the identity of the at least one marking element.

Thus, the marking element includes one or more substrings where at least one or more substrings is a hexadecimal number.²

As described in the specification in a non-limiting embodiment,³ for **space reasons** the marking element is restricted to a certain number of characters, e.g., about ten, to make the reading easier to understand and easier to transmit without error. These characters include one or more combinations of numerals and letters which correspond, for example, to numeric and hexadecimal codings intended to be understood in a computerized manner at the input to the database. The use of **hexadecimal** coding advantageously allows numbers to be coded on **fewer characters** than they can be with numerical coding. This is why hexadecimal coding will be preferred in order to use fewer characters so that the **marking element takes up less space**.

In contrast, Andersen fails to disclose a string of characters which contain one or more substrings of one or more successive characters where at least one of the one or more substrings is a hexadecimal number. In Andersen the safety glazing identification code is

² Hexadecimal is a *positional numeral system* with a base of 16. It uses sixteen distinct symbols, most often the symbols 0-9 to represent values zero to nine, and A, B, C, D, E, F to represent values ten to fifteen. For example, the hexadecimal number 2AF3 is equal, in decimal, to $(2 \times 16^3) + (10 \times 16^2) + (15 \times 16^1) + 3$, or 10,995. “Hexadecimal” at <http://en.wikipedia.org/wiki/Hexadecimal> (last visited, January 11, 2010).

³ Specification, as published, at paragraphs [0083] to [0086].

limited to information required by Federal safety glazing codes, IGCC codes, and ANSI codes.⁴ The safety glazing identification code information includes mostly letter abbreviations for the category of glass (A, B, or C), a decimal-number or a short-lettered word representation for a plant location, and letters to represent the month and year in which the glass was manufactured.⁵ These are not hexadecimal numbers.

Accordingly, since Andersen fails to disclose a string of characters which contain one or more substrings of one or more successive characters where at least one of the one or more substrings is a hexadecimal number, Andersen does not set forth each and every element of amended independent Claim 28. Therefore, it is respectfully submitted that the glazing unit recited in Claim 28, and any claims depending therefrom, patentably distinguish over Andersen.

Regarding dependent Claim 37, this claim recites, in part:

the identification device includes a computer database in which all characteristics relating to the glazing unit are recorded in a form of a string of numbers, each number of the string of numbers is coded as a hexadecimal number to comprise one of the one or more substrings of the at least one marking element.

Thus, the identification device includes a computer database. Each number of the string of numbers is coded as a hexadecimal number to comprise one of the one or more substrings of the at least one marking element.

Andersen fails to disclose the above-noted features. Specifically, there is no identification device in Andersen which includes a computer database. Andersen only states a service replacement parts call number. There is no disclosure as to who or what a telephone call dialed using the call number would connect to.

⁴ Andersen at page 7.

⁵ Andersen at pages 7-15.

Furthermore, Andersen fails to teach coding a number of the string of numbers as a hexadecimal number. The only use of any coding in Andersen is the description of using a letter, e.g., C, to indicate the quarter of the year in which the glass was made⁶ and using letters to represent the month and year in which the glass was manufactured. These are not coded as a hexadecimal number.

Accordingly, Claim 37 further patentably distinguishes over Andersen for the above-noted features.

Regarding dependent Claim 40, applicants respectfully submit that the application of IGCC as evidence of the present invention being in public use or on sale is improper as the IGCC itself has no publication date, and the IGCC's date of printing is listed as being "1/8/2010" (see bottom-right-hand corner of IGCC). § 102(b) requires that the invention be "in public use or on sale in this country, **more than one year prior** to the date of the application for patent in the United States." The only date listed on the IGCC is its printing date, which postdates the present application by more than three years.

Additionally regarding Claim 40, none of the safety glazing identification codes in Andersen identifies a thickness of the gas-filled cavity, composition of the gas-filled cavity, and technical characteristics of the interlayer. The outstanding Office Action asserts that these characteristics are taught by virtue of having an IGCC certification and references IGCC for disclosure of such. Applicants respectfully disagree. IGCC only states the requirements for **testing a sample**. The purpose of the requirements in IGCC is so that a representative can be sent to the plant and witness the manufacturing of the sample (prototype) under standardized conditions.⁷ Thus, having a marking element containing "IGCC" or "SGCC" only signifies that a sample of that glazing unit meets IGCC certification requirements. It does not necessarily signify a thickness of the gas-filled cavity, composition

⁶ Andersen at page 9.

⁷ IGCC at page 1.

of the gas-filled cavity, and technical characteristics of the interlayer of a specific production glazing unit.

Accordingly, Applicants respectfully submit that Claim 40 further patentably distinguishes over Andersen.

Regarding the rejection of amended independent Claim 43, Claim 43 recites, in part:

after the recognizing, **transmitting** a content of the at least one marking element **via a first technical communication device** to an **identification device including a computer database**,

identifying via the identification device **one or more hexadecimal numbers** from a string of characters of the at least one marking element,

correlating via the computer database the one or more numbers with an item of information in the computer database, and

passing-on at least some of the item of information publicly **via a second technical communication device**.

Thus, a content of the at least one marking element is transmitted via a first technical communication device to an identification device containing a computer. One or more hexadecimal numbers are identified via the identification device from a string of characters of the at least one marking element. The computer database correlates the one or more numbers with an item of information in the computer database, and passes-on at least some of the item of information publicly via a second communication device.

In contrast, Andersen contains instructions on how to identify safety glazing information on a window. Andersen fails to disclose transmitting a content of the at least one marking element via a first technical communication device to an identification device including a computer database. As discussed above regarding Claim 37, there is no identification device which includes a computer database. Andersen only states a service replacement parts call number. There is no disclosure as to who or what a telephone call dialed using the call number would connect to. Accordingly, there is no description of an

identification device including a computer database, even more, one which could receive a content of the at least one marking element.

Further, as similarly described above regarding Claim 28, Andersen fails to disclose identifying via the identification device one or more hexadecimal numbers from a string of characters of the at least one marking element. There is no identification device include a computer database in Andersen and the safety identification codes in Andersen **do not** include hexadecimal numbers. Instead, the safety identification codes are limited to abbreviated words, decimal numbers, and letters to represent the manufacturing plant, dates of manufacture, and some general information about the window.

Thus, it follows that Andersen also fails to disclose correlating via the computer database the one more numbers with an item of information in the computer database, since there is no computer database in Andersen. Further, Andersen fails to disclose a second technical communication device, and therefore cannot teach passing-on at least some of the item of information publicly via a second technical communication device.

Accordingly, Andersen fails to disclose each and every element of amended independent Claim 43. Thus, it is respectfully submitted that the method of Claim 43, and all claims depending therefrom, was not in public use or on sale more than one year prior to the date of the application for patent in the United States, and it is respectfully requested that the rejection of Claims 43-46 and 52-54 be withdrawn.

Similarly, regarding the rejection of Claims 47, 50, 51, and 53, amended independent Claim 47 recites a system for identifying a glazing unit comprising substantially similar features as those discussed above with respect to Claim 43. Claim 53 depends from Claim 43 and is patentable for the reasons discussed above regarding that claim. Thus, it is respectfully submitted that the system of Claim 47, and all claims depending therefrom, was not in public

use or on sale more than one year prior to the date of the application for patent in the United States, and it is respectfully requested that the rejection of Claims 47-51 be withdrawn.

Regarding the rejection of Claim 42 as unpatentable over Andersen in view of Demars. Demars fails to remedy the deficiencies of Andersen as discussed above regarding Claim 28. Thus, since Claim 42 depends from Claim 28, Claim 42 is patentable at least by virtue of its dependency from Claim 28. Accordingly, it is respectfully requested the rejection of Claim 42 under 35 U.S.C. § 103(a) be withdrawn.

Consequently, in light of the above discussion, and in view of the present amendments, the present application is believed to be in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Philippe J.C. Signore, Ph.D.
Attorney of Record
Registration No. 43,922

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/09)

Lee L. Stepina
Registration No. 56,837